

### **Remarks**

The Office Action dated October 1, 2007 has been carefully reviewed and the foregoing amendments are submitted in consequence thereof.

Applicant believes that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 30-35, 38-50 and 53-56 are now pending in the present application, of which claims 30, 31 and 48 have been amended. Claim 52 has been cancelled. It is respectfully submitted that the pending claims define allowable subject matter.

#### **A. The § 112 Rejections**

The rejection of claims 30-35, 38-47 and 51 under 35 U.S.C. § 112, second paragraph is respectfully traversed.

The Office Action states on page 2 that claims 30 and 51 recite the towing handle being pivotable relative to the distal end, but the claim fails to provide any structural detail to enable such functionality. This assertion is traversed for several reasons.

Preliminarily, Applicants note that claim 51 was cancelled in Applicants' previous response and is not presently pending.

On page 4 of the Office Action it is asserted that the claims are incomplete for omitting essential elements, citing MPEP § 2172.01. It is not believed, however, that Applicants have disclosed any particular "essential" or "critical" feature (*see* MPEP § 2164.08(c)), nor is it believed that there is Applicants have made any statement on the present record that would provide a basis for concluding that an essential features is present but not claimed. The Office's reliance on MPEP § 2172.01 therefore appears to be misplaced.

Applicants point out that specific structure was claimed and allowed in the parent patent to the present application, and MPEP § 2172 III states that Applicants may shift the focus of

claims directed to originally disclosed subject matter in a continuation application without necessarily running afoul of § 112, ¶ 2.

It is noteworthy that the present rejection does *not* state that the claims are ambiguous, unclear, or not amenable to reasonable interpretation. Rather, the position taken in the Office Action appears to reflect a general objection to recitations expressed in functional language.

Applicants respectfully submit that the absence of “structural detail to enable” recited functionality is not a basis for a § 112, ¶ 2 rejection where the claim is otherwise clear. Applicants refer to the Office Examination Policy regarding rejections under Section 112 that, consistent with the applicable law, notes that the essential question under § 112, ¶ 2 is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. If the scope of the invention sought to be patented cannot be determined from the language of the claims, a § 112, ¶ 2 rejection is appropriate. Such rejections are inappropriate, however, when the disclosure and claims are sufficient for one skilled in the art to understand. The present claims are submitted to be clear, precise and particular in their scope, which is all that § 112, ¶ 2 requires.

MPEP § 2173.02 cautions the Office that an examiner should not reject claims or insist on their own preferences if other modes of expression satisfy the statutory requirements. In the instant rejection, the Office appears to strongly advocate a preference of structure recited in the claims to effect the recited function in the claims. Nowhere, however, does § 112 require recital of structure in the manner suggested in the Office Action. Indeed, MPEP § 2173.04 notes that if the enabling disclosure of the specification is not commensurate with the scope of the claim, that fact does not render the claim imprecise or indefinite or otherwise noncompliant with § 112, ¶ 2. Applicants need not, therefore, recite in the claims specific structure disclosed in the specification to satisfy § 112, ¶ 2. Applicants are free to draft claims having a scope that is not necessarily limited specifically and exactly to embodiments disclosed, and as long as the claims are presented with sufficient particularity and clarity, the Office should not object unless other requirements of patentability are not met.

It is also clear from MPEP § 2173.04 that breadth of claim does not render it indefinite, and if the scope of a claim is clear (metes and bounds) then it complies with § 112, ¶ 2. MPEP § 2173.05(g) also states that functional language does not, in itself, render claim language indefinite. That is, a functional limitation must be evaluated and considered, just like any other limitation of the claim – for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The scope of the present claims, including structure and functional aspects thereof, are submitted to be readily ascertainable and understood by those in the pertinent art. Consequently, claims 30-35, 38-47 and 52 are submitted to meet the requirements of § 112, ¶ 2.

Applicants accordingly request reconsideration and withdrawal of the § 112, ¶ 2 rejections.

#### B. The Prior Art Rejections

Applicants will now consider the prior art rejections in the order set forth in the Office Action.

##### 1. Sadow in view of Liang and Miyoshi

The rejection of claims 30, 31, 34, 35 and 38-48 under 35 U.S.C. § 103(a) as being unpatentable over Sadow in view of Liang and further in view of Miyoshi is respectfully traversed.

The Office concedes on page 2 of the Office Action that Sadow does not disclose a handle being pivotable relative to the distal end of the arm portion.

Liang is cited in the Office Action as disclosing an arm portion with an adjustable length and a handgrip that can pivot about the distal end of the arm, and the Office Action asserts that it would be an obvious alternative to use the Liang handle in the bag of Sadow. The Liang handle (42), as depicted in Figure 10 and described at col. 4, lines 46-58, includes a handle securing ridge (70) configured for rotatable mounting about a second retaining lip (72) on the end of the

rod (56). That is, Liang discloses a handle (42) that mounts directly to the rod (56), and the handle (42), including the securing ridge (70), rotates as a single piece upon the rod (56).

Independent claim 30 now recites, in combination with other recitations, “an arm portion retractably engaged to said piece of baggage and having an adjustable axial length extending between opposite proximal and distal ends,” “a connector fixedly mounted to said distal end; and a towing handle having a hand grip, the towing handle being separately provided from the connector and engaged to the connector such that said hand grip can pivot relative to said connector about a pivot axis that intersects the hand grip when said arm portion is in said extended position, and such that said towing handle grip is retracted at least partially into said receptacle when said arm portion is in said retracted position.”

Neither Sadow nor Liang neither discloses nor suggests a separately provided connector, and a hand grip that can pivot relative to said connector about a pivot axis that intersects the hand grip as claim 30 recites. As noted above, the Liang handle does not utilize a separately provided connector at all, and there is no apparent reason why such a connector would be desirable or advantageous in view of the teaching of Liang. Applicants also respectfully submit, for the reasons explained in the previous Amendment that the Sadow and Liang references actually teach away from one another on pertinent aspects of the invention as claimed.

Myoshi is cited for teaching a plurality of telescoping portions. Applicants point out that Sadow already teaches telescoping portions so the Myoshi patent is believed to be redundant on this aspect. Nevertheless, Myoshi does not cure the deficiencies of Sadow and Liang with respect to independent claim 30. Indeed, Myoshi fails to disclose a pivoting handle at all, and further fails to disclose a connector that facilitates pivoting of a handle as claimed. It is therefore submitted that Sadow, Liang and Myoshi collectively fail to teach all the recitations of claim 30, and claim 30 is therefore not obvious over Myoshi in view of Liang. Additionally, the disclosure of Myoshi would not reconcile the discrepancies and inconsistencies in the teaching of Sadow and Liang.

Claim 30 is accordingly submitted to be patentable over the cited art, and when the recitations of independent claims 31, 34, 35 and 38-47 are considered in combination with the

recitations of claim 30, claims 31, 34, 35 and 38-47 are likewise submitted to be patentable over the cited art.

Independent claim 48 now recites, in combination with other recitations, “a retractable arm portion, the arm portion comprising a plurality of tubular sections that are telescopically engaged with each other and having an axial length extending between opposite proximal and distal ends”, “a connector mounted stationary to the distal end” and “a towing handle having a hand grip, the towing handle being separately provided from the connector and abutting the connector in a manner such that the hand grip can pivot relative to the connector about a pivot axis that intersects the hand grip when the distal end of the arm portion is in the extended position; wherein the towing handle is generally unobtrusive when in the retracted position.”

Claim 48 is patentable over Sadow, Liang and Myoshi for similar reasons to claim 30. The cited references collectively fail to teach the recited connector and towing handle. Claim 48 is therefore likewise submitted to be patentable over the cited art.

Applicants accordingly request that the § 103(a) rejection of claims 30, 31, 34, 35 and 38-48 be withdrawn.

2. Sadow in view of Liang and Myoshi and further in view of Browning

The rejection of claims 32, 33, 48, 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Sadow in view of Liang and Myoshi and further in view of Browning (U.S. Patent No. 3,606,372) is respectfully traversed.

Browning is cited for teaching an arm having a non-circular cross section. Browning does not cure the deficiencies of Sadow, Liang and Myoshi with respect to the independent claims, and claims 30 and 48 are submitted to be patentable over the cited art. Browning does not teach a separately provided connector and a handle that can pivot relative to the connector, nor does it cure the incompatible teaching concerning certain aspects of the claimed invention that are detailed in Applicants' previous Amendment.

Dependent claims 32, 33, 49, 50 and 54-55, when considered in combination with their respective base claims, are likewise submitted to be patentable over the cited art.

Applicants accordingly request that the rejection of claims 32, 33, 48, 49 and 50 be reconsidered and withdrawn.

3. Williams et al.

The rejection of claims 30, 31, 34, 35, 37, 42-47 and 52 under 35 U.S.C. § 102(b) as being anticipated by Williams et al. (U.S. Patent No. 4,538,709) is respectfully traversed.

Claim 37 was cancelled in Applicants previous Amendment and the rejection appears to be in error in this regard.

Claim 52 is cancelled without prejudice or disclaimer herein, and the rejection is accordingly moot as it pertains to claim 52.

As Applicants explained in detail in the previous Amendment, the Williams et al. handle is believed to be similar to the Sadow handle, and is believed to be distinguishable from the presently claimed invention recited in independent claims 30 for similar reasons. Applicants maintain their position on such issues, and additionally note that Williams et al., like Sadow, fail to disclose a separately provided connector and a handle that can pivot *relative to* the connector as is presently claimed in independent claim 30.

Applicants do not believe that the basis for the interpretation of the Williams et al. cross section set forth on pages 4-5 of the Office Action has been adequately explained. Nothing in the text of Williams et al. explicitly supports the position taken by the Office nor does anything in the Williams et al. disclosure refute Applicants rather detailed comments set forth in the previous Amendment regarding the operation of the Williams et al. handle. As Applicants have noted, Williams et al. is simply silent on material points of the invention being claimed, and it is not believed that the Office can rest upon an interpretation of a cross section that is not supported by any objective evidence on the record, and especially when the Office's interpretation is contradicted by the teaching of the Williams et al. reference itself.

Williams et al. clearly disclose that the telescoping pole (50) includes three portions (50a), (50b) and (50c). See Williams et al. col. 5, lines 27-31 and lines 61-62. The Office Action, however, considers portion (50a) to be a part of the handle, and this is believed to be improper as it is inconsistent on its face with the teaching of Williams et al. The tube portion (50a) is not properly considered to be a handle stem as the Office Action states because the portion (50a) is disclosed as being part of the pole (50) and not part of the handle (20). The alleged rotation of the pole portion (50a) with respect to the pole portion (50b), as the Office Action purports to do, likewise cannot properly be considered to be a handle rotating with respect to a distal end of the pole (50b). The distal end of the pole would be the end of the portion (50a), and not the portion (50b). For similar reasons, the tube portion (50a) would not be fairly characterized as the connector recited in the present independent claims.

The Office Action appears to state that Williams et al. handle (20) is rotatable with respect to tube portion (50a) and the tube portion (50a) is rotatable with respect to the tube portion (50b). While Applicants have some reservations regarding whether this is a fair interpretation of the figure at all, assuming *arguendo* that it is accurate, it would disqualify any element of the Williams et al. handle from being considered a connector as present claimed in the present independent claims. Claim 30 recites a connector being fixedly mounted to a distal end of the arm, and claims 48 and 53 recites a connector mounted stationary to the distal end. Under the interpretation of the cross section set forth in the Office Action, no element of Williams et al. would meet this criteria.

Applicants again specifically point out that in all embodiments of the handle (20) disclosed by Williams et al., the handle includes a button snap (72) that engages a notched receptacle (70) to rigidly hold the handle (20) in place. *See* Williams et al. col. 4, lines 39-48 and Figure 6. As such, when the pole (50) is fully extended, the handle (20) is not pivotable because it is locked relative to the bag via the button snap (72) and the notched receptacle (70). The pivoting of the handle relative to the distal end of a retractable or telescoping arm, when the arm is in the extended position, as recited in independent claim 30 is therefore not disclosed by Williams et al.

Williams et al. is accordingly not an anticipating reference to claims 30, 48 and 53. Likewise, Williams is not believed to suggest the inventions of claims 30, 48 and 53.

Dependent claims 31, 34, 35 and 42-47 depend directly or indirectly from claim 30, and when the recitations of claims 31, 34, 35 and 42-47 are considered in combination with the recitations of claim 30, claims 31, 34, 35, and 42-47 are likewise submitted to be patentable over Williams et al.

Applicants accordingly request that the § 102 rejection of claims 30, 31, 34, 35, 37, 42-47 and 52 over Williams et al. be withdrawn.

#### 4. Browning in view of Kang and further in view of Cheng

The rejection of claims 30-35, 38-40, 42-44, 46-50 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Browning in view of Kang and further in view of Cheng is respectfully traversed.

None of Browning, Kang and Cheng disclose or suggest the connector recited in the independent claims, together with the other recitations recited. Browning does not disclose a pivoting handle. Kang discloses a handle having an integral fastening portion (32) but does not disclose pivoting. Cheng discloses a handle that pivots, but not about an axis intersecting the hand grip as recited in independent claims 30, 48 and 53. The Cheng handle, as is clear from the figures, rotates about an axis parallel to the hand grip. The references accordingly collectively fail to teach or suggest all of the recitations claimed and a prima facie case of obviousness has not been established.

Applicants accordingly submit that all the pending claims are patentable over Browning in view of Kang and further in view of Cheng.

Applicants accordingly request that the § 103 rejection of claims 30-35, 38-40, 42-44, 46-50 and 52 over Browning in view of Kang and further in view of Cheng be withdrawn.




C. The Newly Added Claims

Applicants submit that newly added claim 53 is patentable over the cited art at least for similar reasons to those noted above. The cited art is not believed to teach or suggest all the recitations of claim 53. Applicants invite the Office to consider independent claim 53 and associated dependent claims 54-56 in the next communication.

D. Conclusion

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

  
Bruce T. Atkins, Reg. No.: 43,476  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070